

## **REMARKS:**

Claims 1-35 are currently pending in the Application.

Claims 1-35 stand rejected under 35 § U.S.C. 102(e) as being anticipated by Herz et al. (U.S. Patent Application Publication No. 2001/0014868 to Herz et al., (hereinafter referred to as "*Herz*").

Although the Applicant believes Claims 1-35 are directed to patentable subject matter without amendment, the Applicant has amended independent Claims 1, 12, 23, 34, and 35 and dependent Claims 2-4, 13, and 24 to more particularly point out and distinctly claim the Applicant's invention. By making these amendments, the Applicant makes no admission concerning the merits of the Examiner's rejection, and respectfully reserve the right to address any statement or averment of the Examiner not specifically addressed in this response. Particularly, the Applicant reserves the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

## **REJECTION UNDER 35 U.S.C. § 102(e):**

Claims 1-35 stand rejected under 35 § U.S.C. 102(e) as being anticipated by Herz.

The Applicant respectfully submits that the ***amendments to Claims 1-4, 12, 13, 23, 24, 34, and 35 have rendered moot the Examiner's rejection of these claims and the Examiner's arguments in support of the rejection of these claims***. The Applicant further respectfully submits that amended Claims 1-4, 12, 13, 23, 24, 34, and 35 in their current amended form contain unique and novel limitations that are not taught, suggested, or even hinted at in Herz. Thus, the Applicant respectfully traverses the Examiners rejection of Claims 1-35 under 35 U.S.C. § 102(e) over Herz.

## ***Herz Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Claims***

For example, with respect to independent Claim 1, this claim recites:

An **electronic commerce system that provides market feedback to sellers**, comprising:

one or more memory units storing program instructions for:

**recording query information** associated with a **search query of one or more seller databases containing product data**, the search query involving a search by a buyer;

recording presentation information associated with the manner in which a plurality of search results are presented to the buyer, **each search result comprising data for a product matching one or more search criteria specified in the search query**, the search results comprising one or more search results reflecting product data for a particular seller;

recording selection information associated with selection by the buyer of a particular search result from among the plurality of search results, the particular search result comprising data for a particular product matching one or more search criteria specified in the search query, **wherein the particular product is a product of a seller other than the particular seller**; and

providing the recorded query information and at least one of the presentation information and the selection information to the particular seller **to allow the particular seller to assess one or more aspects of its product data relative to product data of other sellers**; and

one or more processing units that execute the stored program instructions to:

record query information associated with a search query for a buyer of one or more seller databases containing product data;

record presentation information associated with the manner in which a plurality of search results are presented to the buyer, **each search result comprising data for a product matching one or more search criteria specified in the search query**, the search results comprising one or more search results reflecting product data for a particular seller;

record selection information associated with selection by the buyer of a particular search result from among the plurality of search results, the particular search result comprising data for a particular product matching one or more search criteria specified in the search query; and

provide the recorded query information and at least one of the presentation information and the selection information to the particular seller **to allow the particular seller to assess one or more aspects of its product data relative to product data of other sellers**. (Emphasis added).

Independent Claims 12, 23, 34, and 35 recite similar limitations. *Herz* fails to disclose or teach each and every element of independent Claims 1, 12, 23, 34, and 35.

The Applicant respectfully submits that *Herz* fails to disclose, teach, or suggest independent Claim 1 limitations regarding an **“electronic commerce system that provides market feedback to sellers”** and in particular *Herz* fails to disclose, teach, or suggest independent Claim 1 limitations regarding **“recording query information associated with a search query of one or more seller databases containing product data, the search query involving a search by a buyer”**. In particular, the Examiner equates **“recording query information”** recited in independent Claim 1 with **“collecting records”** disclosed in *Herz*. (20 March 2007 Final Office Action, Pages 3-4). However, **“collecting records”** disclosed in *Herz* is merely collecting records of information requested by a shopper, **but does not include, involve, or even relate to recording query information**, as recited in independent Claim 1. (Column 3, Paragraph [0022], Lines 8-12). In contrast, **“recording query information”** recited in independent Claim 1 provides for **query information that is recorded, wherein the query information is information that is associated with a search query, wherein the search query is performed on one or more seller databases, of which the one or more seller databases contains product data**. Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner’s comparison between *Herz* and independent Claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish independent Claim 1 from *Herz*.

The Applicant respectfully submits that *Herz* fails to disclose, teach, or suggest independent Claim 1 limitations regarding **“recording presentation information associated with the manner in which a plurality of search results are presented to the buyer, each search result comprising data for a product matching one or more search criteria specified in the search query, the search results comprising one or more search results reflecting product data for a particular seller”**. In particular, *Herz* paragraph [0038], lines 1-9, fails to disclose, teach, or suggest the feature of **“each search result comprising data for a product matching one or more search criteria specified in the search query”**. Paragraph [0038] of *Herz* merely teaches that text

and/or graphics messages are sent to a shopper's terminal in order to convey "selected offers". However, lines 5-8 explain that "Offers that are directly related to the shopper's stated goals might be displayed more centrally **than offers that the shopper might be interested in but has not explicitly asked for**". (Emphasis Added). In paragraph [0036], *Herz* explains that a "shopper's goal" is what the shopper is interested in, such as by browsing for the keyword "dress shirts". Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner's comparison between *Herz* and independent Claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish independent Claim 1 from *Herz*.

The Applicant further respectfully submits that *Herz* fails to disclose, teach, or suggest independent Claim 1 limitations regarding "recording selection information associated with selection by the buyer of a particular search result from among the plurality of search results, the particular search result comprising data for a particular product matching one or more search criteria specified in the search query, **wherein the particular product is a product of a seller other than the particular seller**". For example, in paragraph [0278] *Herz* teaches that vendors are excluded from information relating to selections unless they were the selected vendor. In contrast, independent Claim 1 recites that the selection information recorded and sent to a seller is information about the **selection of products other than the seller's own products**. In fact, *Herz* actually teaches away from the claimed invention regarding "recording selection information associated with selection by the buyer of a particular search result from among the plurality of search results, the particular search result comprising data for a particular product matching one or more search criteria specified in the search query, **wherein the particular product is a product of a seller other than the particular seller**." Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner's comparison between *Herz* and independent Claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish independent Claim 1 from *Herz*.

The Applicant respectfully submits that *Herz* fails to disclose, teach or suggest the independent Claim 1 limitation regarding “providing the recorded query information and at least one of the presentation information and the selection information to the particular seller **to allow the particular seller to assess one or more aspects of its product data relative to product data of other sellers.**” The Final Office Action alleges that this feature is taught by *Herz* in paragraphs [0260]; [0261], lines 1-10; and [0278]. *Herz*, paragraph [0260] teaches about “virtual mall” layouts and determining better shelf space. As *Herz* explains, different shoppers are shown different virtual shopping mall layouts and their relative purchase rates of the desired product from the different layouts would be compared. However, this passage of *Herz* fails to disclose, teach, or suggest providing the recorded query information to a particular seller so that allows the seller to assess one or more aspects of its product data relative to product data of other sellers. *Herz* only teaches **comparing the sales rate of the same seller and product at different locations within the virtual mall.** *Herz* does not disclose, teach, or suggest giving the seller product data of other sellers. Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner’s comparison between *Herz* and independent Claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish independent Claim 1 from *Herz*.

### **The Office Action Fails to Properly Establish a *Prima Facie* case of Anticipation over *Herz***

The Applicant respectfully submits that the allegation in the present Office Action that *Weinberg* discloses all of the claimed features is respectfully traversed. Further, it is noted that the Office Action provides no concise explanation as to how *Herz* is considered to anticipate all of the limitations in Claims 1-35. ***A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if each and every element of a claimed invention is identically shown in that single reference.*** MPEP § 2131. (Emphasis Added).

With respect to the subject application, the Examiner has not adequately supported the rejection under 35 U.S.C. § 102, because the Examiner has not shown how each and every element of the Applicants claimed invention is identically shown in *Weinberg*. For example, the Examiner asserts that “**recording query information**”, in independent Claim 1 is somehow equivalent to collecting records. (20 March 2007 Final Office Action, Pages 3-4). The Applicant respectfully disagrees and further respectfully requests clarification as to how the Examiner arrives at this conclusion.

The Applicant respectfully points out that "it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." Ex parte Levy, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990). The Applicant respectfully submits that ***the Office Action has failed to establish a prima facie case of anticipation in Claims 1-35 under 35 U.S.C. § 102 with respect to Herz because Herz fails to identically disclose each and every element of the Applicant's claimed invention, arranged as they are in Applicant's claims.***

### **The Applicant's Claims are Patentable over Herz**

With respect to independent Claims 12, 23, 34, and 35, these claims include limitations similar to those discussed above in connection with independent Claim 1. Thus, independent Claims 12, 23, 34, and 35 are considered patentably distinguishable over *Herz* for at least the reasons discussed above in connection with independent Claim 1.

Furthermore, with respect to dependent Claims 2-11, 13-22, 24-33: Claims 2-11, depend from independent Claim 1; Claims 13-22 depend from independent Claim 12; and Claims 24-33 depend from independent Claim 23 are also considered patentably distinguishable over *Herz*. Thus, dependent Claims 2-11, 13-22, 24-33 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

Thus, for at least the reasons set forth herein, the Applicant respectfully submits that Claims 1-35 are not anticipated by *Herz*. The Applicant further respectfully submits

that Claims 1-35 are in condition for allowance. Thus, the Applicant respectfully requests that the rejection of Claims 1-35 under 35 U.S.C. § 102(e) be reconsidered and that Claims 1-35 be allowed.

### **THE LEGAL STANDARD FOR ANTICIPATION REJECTIONS UNDER 35 U.S.C. § 102:**

The following sets forth the legal standards for "anticipation."

The events that can lead to anticipation can be divided into the following seven categories, all defined by statute:

1. Prior Knowledge: The invention was publicly known in the United States before the patentee invented it.
2. Prior Use: The invention was publicly used in the United States either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.
3. Prior Publication: The invention was described in a printed publication anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.
4. Prior Patent: The invention was patented in another patent anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his application.
5. On Sale: The invention was on sale in the United States more than one year before the patentee filed his application.
6. Prior Invention: The invention was invented by another person in the United States before the patentee invented it, and that other person did not abandon, suppress or conceal the invention.

7. Prior U.S. Patent: The invention was described in a patent granted on a patent application filed in the United States before the patentee made the invention.

Each of those seven events has its own particular requirements, but they all have the following requirements in common:

1. Anticipation must be shown by clear and convincing evidence.
2. If one prior art reference completely embodies the same process or product as any claim, the product or process of that claim is anticipated by the prior art, and that claim is invalid. To decide whether anticipation exists, one must consider each of the elements recited in the claim and determine whether all of them are found in the particular item alleged to be anticipating prior art.
3. There is no anticipation unless every one of those elements is found in a *single* prior publication, prior public use, prior invention, prior patent, prior knowledge or prior sale. One may not combine two or more items of prior art to make out an anticipation. One should, however, take into consideration, not only what is expressly disclosed or embodied in the particular item of prior art, but also what inherently occurred in its practice.
4. There cannot be an accidental or unrecognized anticipation. A prior duplication of the claimed invention that was accidental, or unrecognized, unappreciated, and incidental to some other purpose is not an invalidating anticipation.

Those four requirements must be kept in mind and applied to each kind of anticipation in issue. The following additional requirements apply to some categories of anticipation.

1. Prior Knowledge: An invention is anticipated if it was known by others in the United States before it was invented by the patentee. "Known," in this context, means known to the public. Private knowledge, secret knowledge or knowledge confined to a small, limited group is not necessarily an invalidating anticipation. Things that were known to the public only outside the United States are not invalidating anticipation.



2. Prior Use: An invention is anticipated if it was used by others before it was invented by the patentee, or more than one year before the patentee filed his patent application. "Use," in this context, means a public use.

3. Prior Publication: A patent is invalid if the invention defined by the claims was described in a printed publication before it was invented by the patentee or more than one year prior to the filing date of his application. For a publication to constitute an anticipation of an invention, it must be capable, when taken in conjunction with the knowledge of people of ordinary skill in the art, of placing the invention in the possession of the reader. The disclosure must be enabling and meaningful. In determining whether the disclosure is complete, enabling, and meaningful, one should take into account what would have been within the knowledge of a person of ordinary skill in the art at the time, and one may consider other publications that shed light on the knowledge such a person would have had.

4. Prior Patent: If the invention defined by the claims was patented in the United States or a foreign country, either before it was invented by the inventor or more than one year before the inventor filed his patent application, then the invention was anticipated. The effective date for this type of anticipation is the date on which two things co-existed: (i) the owner of the referenced patent had the right to enforce that patent; and (ii) the reference patent was available to the public. What was "patented" in the reference patent is determined by what is defined by its claims, interpreted in the light of the general description.

5. On Sale: A patent is invalid if the invention claimed in it was on sale in the United States more than one year prior to the application filing date.

6. Prior Invention: If the invention defined by the claims was invented by another person, in the United States, before it was invented by the inventor, and that other person did not abandon, suppress, or conceal the invention, the invention lacks novelty. A prior invention, even if put in physical form and shown to produce the desired result, is not

an invalidating anticipation unless some steps were taken to make it public. However, it is not necessary that the inventor had knowledge of that prior invention.

7. Prior U.S. Application: A patent is invalid for lack of novelty if the invention defined by the claims was described in a United States patent issued on a patent application filed by another person before the invention was made by the inventor. The effective date of a prior application for purposes of this issue is the date on which it was filed in the United States. Foreign-filed patent applications do not apply. If the issued United States patent claims the benefit of more than one United States application, its effective date as an anticipation is the filing date of the first United States application that discloses the invention claimed in that referenced patent.

Experimental Use Exception: The law recognizes that it is beneficial to permit the inventor the time and opportunity to develop his invention. As such there is an "experimental use" exception to the "public use" and "on sale" rules. Even though the invention was publicly used or on sale, more than one year prior to the application filing date, that does not invalidate the patent, provided the principal purpose was experimentation rather than commercial benefit. If the primary purpose was experimental, it does not matter that the public used the invention or that the inventor incidentally derived profit from it.

When a public use or sale is shown, the burden is on the inventor to come forward with evidence to support the experimental use exception. Only experimentation by or under the control of the inventor qualifies for this exception. Experimentation by a third party, for its own purposes, does not qualify for this exception. Once the invention leaves the inventor's control, its use is a public one, even if further experimentation takes place.

The experimentation must relate to the claimed features of the invention. And it must be for the purpose of technological improvement, not commercial exploitation. If any commercial exploitation does occur, it must be merely incidental to the primary purpose of experimentation. A test done primarily for marketing, and only incidentally for technological improvement, is a public use.

**CONCLUSION:**

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although the Applicant believes no fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

**Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.**

Respectfully submitted,

3 May 2007  
Date

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